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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/802,472    02/18/97    KORMANIK

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EXAMINER
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PM82/0711

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ART UNIT	PAPER NUMBER
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3618

19 20

DATE MAILED:

07/11/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/802,472

Applicant(s)

Kormanik, Jr.

Examiner

Matthew Luby

Group Art Unit

3618



☒ Responsive to communication(s) filed on Jun 21, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-5, 8-15, and 17-31 is/are pending in the application.

Of the above, claim(s) 1-4 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 5, 8-15, and 17-31 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3618

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

*Claims 24-26 are rejected under 35 USC § 112, 2nd paragraph for being vague and indefinite.*

2. A broad range or limitation together with a narrow range or limitation that falls within the

broad range or limitation (in the same claim) is considered indefinite, since the resulting claim

does not clearly set forth the metes and bounds of the patent protection desired. Note the

explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10

USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by

"such as" and then narrow language. The Board stated that this can render a claim indefinite by

raising a question or doubt as to whether the feature introduced by such language is (a) merely

exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of

the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd.

App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481

(Bd. App. 1949). In the present instance, claims 24-26 and 31 recite the broad recitations "an

object" (claim 24, line 3); "~~a package~~" (claim 25, line 4) and "~~the package~~" (claim 26, line 4), and

the claim also recites "a particular ball" (claim 24, line 3); "a golf ball" (claim 25, line 11) and "a

baseball" (claim 26, line 12) which are the narrower statements of the range/limitation.

Art Unit: 3618

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 5, as best understood, is rejected under 35 U.S.C. 102(b) as being anticipated by Agapiou (4,815,607).

Agapiou discloses the claimed method for making a package and article including constructing the package as a “recognizable icon” (10) which has a shape different than the shape of the article inside (the package is a tire and the article is a toy - see Figure 3, for example) and is hollow (see Figure 2), the shape of the package visually conveying information about an activity associated with the icon (all shapes visually convey information about an activity associated with package; in this case the tire shape visually conveying information about a safety activity for learning about safety procedures around motor vehicles) and locating the article within the hollow interior of the package (col. 2, lines 4-6).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 3618

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8-15 and 17-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agapiou.

Agapiou discloses the claimed method including the package and article as described above including constructing the replica to receive writing from a pen or magic marker (see 30 - Figure 1). Agapiou does not particularly recite that the package resembles a particular ball, that the article is one of a wiping cloth, a rain coat, a rain vest, a golf bag cover, a ditty bag, a poncho, a hat and a seat cover; that the package is constructed as either a replica of a golf ball, a baseball, a life preserver, a football, a tennis ball, a soccer ball, a rugby ball or a charge/bank card and that the article is rain gear or any other item useful during the activity. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Agapiou reference by having the package resemble a particular ball, that the article is selected from the group including a wiping cloth, a rain coat, a rain vest, a golf bag cover, a ditty bag, a poncho, a hat and a seat cover; that the package is constructed as either a replica of a golf ball, a baseball, a life preserver, a football, a tennis ball, a soccer ball, a rugby ball or a charge/bank card and that the article is rain gear, since a person of ordinary skill in the art at the time of the invention would provide a package with an article inside to resemble objects useful to the target consumer(s) who would purchase these items. It is notoriously well known to place rain gear or any other article, for that

Art Unit: 3618

matter, inside a package. Further it is also well known to construct that package to resemble a familiar symbol to the target consumer(s).

### *Response to Arguments*

7. Applicant's arguments filed 6/21/00 have been fully considered but they are not persuasive.

All of the 112, 2nd paragraph rejections and 101 rejections made in Paper No. 18 have been overcome by Applicant's amendment filed 6/21/00 except for those listed above.

Applicant's argument on page 4 that "there is no disclosure, suggestion or motivation provided to create a package in the form of an icon having a particular activity visually associated therewith and placing an item useful in the activity within the package" (page 4, lines 25-27). This is clearly not the case as has been outlined for the Applicant in the above paragraph 4, which states that the "package in the form of an icon" is 10 (i.e., a tire "icon"), where the activity is learning about safety awareness and the item useful in the activity would be the contents as shown in Figure 3, for example.

Since no further arguments have been presented no further response is forthcoming.

### *Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3618

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew Luby whose telephone number is (703) 305-0441. The examiner can normally be reached weekdays from 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson, can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

m.l. *ML*

July 5, 2000

*Matthew Luby*

*Brian L. Johnson*  
BRIAN L. JOHNSON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600  
7/13/00